

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB MARCH 13, 00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Hyder PLC

Serial No. 75/123,524

John M. Keene and H. John Campaign of Graham, Campaign P.C.
for applicant.

Steven R. Foster, Trademark Examining Attorney, Law Office
107 (Thomas Lamone, Managing Attorney).

Before Simms, Hanak, and McLeod, Administrative Trademark
Judges.

Opinion by McLeod, Administrative Trademark Judge:

An intent-to-use application has been filed by Hyder
PLC to register the mark HYDER for a variety of services in
a number of fields, including construction, engineering,
power distribution and waste treatment.¹

The Trademark Examining Attorney has finally refused
registration under Section 2(e)(4) of the Trademark Act, 15

¹ Application Serial No. 75/123,524, filed June 21, 1996, based
upon a bona fide intent to use the mark in commerce under Section
1(b), 15 U.S.C. § 1051(b).

U.S.C. § 1052(e)(4), on the ground that applicant's mark is primarily merely a surname.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney have filed briefs. An oral hearing was not requested. We affirm.

In support of his surname refusal, the Examining Attorney has made of record the results of two different searches from a database containing approximately ninety million surnames: (1) 1,840 HYDER surname listings from PHONEDISC POWERFINDER USA ONE 1997 (3rd ed.), and (2) 1514 HYDER surname listings from PHONEDISC U.S.A. (1995 ed.), of which the first one hundred listings were submitted. The Examining Attorney also relies upon the first fifty of 3,293 articles from the NEXIS database containing the term HYDER. Additional evidence from Elsdon C. Smith, *American Surnames*, 1969, describes the origin of the HYDER surname, and an excerpt from *Webster's New Collegiate Dictionary*, 1979, shows that there is no listing of the term "Hyder" in the dictionary.

Applicant contends that the Examining Attorney has failed to establish a prima facie surname case. Applicant challenges the Examining Attorney's PHONEDISC and NEXIS evidence on the ground that it represents a small fraction of the total databases' content. Applicant submits that

such evidence is indeterminate of the primary significance of the term to purchasers. According to applicant, an "unusually large number" of telephone directory listings is required for a surname refusal. As a result, applicant concludes that HYDER is, at most, a rare surname. Applicant also asserts, among other things, that HYDER is the phonetic equivalent of the English words "hide" or "hider", the name of a small town in Alaska, a given name, and a Welsh word meaning "confidence." In support of its position, applicant relies upon various dictionary definitions,² and an excerpt from Bruce Lansky, *35,000+ Baby Names* 341 (1995). Applicant also submitted a printout from the Internet which describes the town of Hyder, Alaska.

The test for determining whether a mark is primarily merely a surname is the primary significance of the mark to the purchasing public. *In re Hutchinson Technology Inc.*, 852 F.2d 552, 554, 7 UPQ2d 1490, 1492 (Fed. Cir. 1988), citing *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 184 USPQ 421 (CCPA 1975) and *In re Harris-Intertype Corp.*, 518 F.2d 629, 186 USPQ 238 (CCPA 1975). The initial burden is on the Examining Attorney to establish a prima facie case

² While some of this evidence was not submitted prior to appeal, the Board may take judicial notice of dictionary definitions. See Trademark Rule 2.142(d); *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

that a mark is primarily merely a surname. *Hutchinson Technology*, 852 F.2d at 554, 7 UPQ2d at 1492; *In re Etablissements Darty et Fils*, 759 F.2d 15, 16, 225 USPQ 652, 653 (Fed. Cir. 1985). After the Examining Attorney establishes a prima facie case, the burden shifts to the applicant to rebut this finding. *Hutchinson Technology, supra*.

The Board, in the past, has considered several different factors in making a surname determination under Section 2(e)(4): (i) the degree of surname rareness; (ii) whether anyone connected with applicant has the surname; (iii) whether the term has any recognized meaning other than that of a surname; and (iv) the structure and pronunciation or "look and sound" of the surname. *In re Benthin Management GmbH*, 37 USPQ2d 1332 (TTAB 1995).

There is no doubt that the Examining Attorney has met his initial burden of establishing that HYDER has primary surname significance to consumers. In particular, the Examining Attorney has presented over eighteen hundred HYDER surname references from the PHONEDISC and NEXIS databases, along with an excerpt from *American Surnames* and proof that HYDER does not appear in dictionaries as an English word. The Court of Appeals for the Federal Circuit has held that this type of evidence is sufficient to establish a prima

facie surname case. See *Hutchinson Technology*, 852 F.2d at 554, 7 USPQ2d at 1492; *Darty*, 759 F.2d at 16, 225 USPQ at 653; see also 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 13.30, pp. 13-50 (4th ed. 1999).

We reject applicant's contention that the Board should adopt a "brightline" standard for the number of computer database listings required or the weight to be accorded such evidence in a surname analysis. Whether a term sought to be registered is primarily merely a surname can only be resolved on a case-by-case basis after consideration of a number of different factors. See *Darty*, 759 F.2d at 16, 225 USPQ at 653; *Benthin Management*, 37 USPQ2d at 1333. As stated in the past, there is no minimum or "magic" number of directory listings required to establish a prima facie surname case. *In re Cazes*, 21 USPQ2d 1796, 1797 (TTAB 1991); *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564, 1566 (TTAB 1988), *aff'd unpublished decision*, No. 89-1231 (Fed. Cir. 1989). It is true that computer database evidence may, in some cases, constitute a small fraction of the total database content. However, the quantum of evidence which may be persuasive for finding surname significance in one case may be insufficient in another because of differences in the surnames themselves and/or consideration of other surname factors. *Darty, supra*.

In this case, we do not believe that HYDER is a rare surname with only a relatively few people with this name. The Examining Attorney's NEXIS evidence³ demonstrates that the HYDER surname appears in widely disseminated printed publications such as newspapers, magazines and journals.⁴ Furthermore, the PHONEDISC evidence is collected from telephone directories and address books across the country. It is reasonable to conclude from these submissions that HYDER, while obviously not as common as some other surnames, has had measurable public exposure.⁵ In any event, this

³ Applicant's objection to the Examining Attorney's NEXIS evidence on the ground that he intentionally submitted only a small fraction of the total search results is not well taken. The Board has consistently held that it is not necessary for the Examining Attorney to submit all of the stories found in a search of the NEXIS database. See *In re Vaughn Furniture Co. Inc.*, 24 USPQ2d 1068 (TTAB 1992); *In re Homes & Land Publishing Corp.*, 24 USPQ2d 1717 (TTAB 1992), and cases cited therein. The Examining Attorney need only submit a sufficient number of stories to enable the Board to determine the significance of the term in question to the relevant public. See *Vaughn, supra*. We are convinced that the Examining Attorney's random sampling of the first fifty NEXIS articles constitutes a fair representation of the entire search results. This is not a situation where the Examining Attorney culled only the best articles to support his case. See *In re Monotype Corp. PLC*, 14 USPQ2d 1070 (TTAB 1989).

⁴ For example, there are excerpts from The Arizona Republic, The Dallas Morning News, The Indianapolis Star, The News Tribune (Tacoma, WA), The Tennessean, The Atlanta Journal and Constitution, Anchorage Daily News, The Fort Worth Star-Telegram, Telegram & Gazette (Worcester, MA), The Florida Times-Union (Jacksonville, FL), The Orange County Register, Milwaukee Journal Sentinel, and The Rocky Mountain News (Denver, CO).

⁵ To the extent applicant contends that HYDER is an uncommon surname, we would point out that even uncommon surnames may not be registrable on the Principal Register. See *Industrie Pirelli*, 9 USPQ2d at 1566.

evidence is far more significant than the number of listings presented in other cases where the surname has been categorized as "rare." See e.g. *Kahan & Weisz*, 508 F.2d at 832, 184 USPQ at 422 (six DUCHARME surname telephone directory listings); *In re Sava Research Corp.*, 32 USPQ2d 1380 (TTAB 1994)(one hundred SAVA surname telephone directory listings); *Benthin Management*, 37 USPQ2d at 1333 (one hundred BENTHIN surname telephone directory listings); *In re Garan, Inc.*, 3 USPQ2d 1537 (TTAB 1987)(six GARAN telephone directory listings and one NEXIS listing).

We have considered applicant's contention that HYDER has recognized meanings other than that of a surname.⁶ However, these uses are somewhat remote or obscure, and would not be known by most people. Thus, they do not rebut the Examining Attorney's prima facie surname case.⁷ The town

⁶ The dissent weighs the third *Benthin* factor in favor of applicant because the term HYDER "has meanings other than that of a surname." However, both the *Benthin* decision and our primary reviewing court clearly require that the other meanings be "recognized" by a significant number of people. See *Harris-Intertype, supra*; *Benthin Management, supra*. For the reasons stated above, the majority does not believe that a significant number of people would recognize the other meanings proffered in this case.

⁷ Applicant's position that the "non-surname meanings", taken collectively, should be afforded more weight is not well taken. This case does not turn on the total number of other possible meanings; rather, it is whether the primary significance of HYDER to consumers is that of a surname. The fact that HYDER has a few other obscure or remote meanings is insufficient to take it out of the "primarily merely a surname" category. See *Harris-Intertype, supra*; *In re Hamilton Pharmaceuticals Ltd.*, 27 USPQ2d 1939, 1942 (TTAB 1993).

of Hyder, Alaska, for example, is a small, obscure town near the Canadian border with a population of 138 residents. See *Harris-Intertype*, 518 F.2d at 631 n.4, 186 USPQ at 239 n.4 (Harris, Missouri, population 174, and Harris, Minnesota, population 559 held obscure); cf. *In re Colt Indus.*

Operating Corp., 195 USPQ 75 (TTAB)(FAIRBANKS (Alaska) so well known as a geographical term that it was not deemed primarily merely a surname). It is significant that, according to applicant's own evidence, Hyder, Alaska was named after a mining engineer from that area. See *Harris-Intertype, supra*; *In re Champion International Corp.*, 229 USPQ 550, 551 (TTAB 1985)(It is a common practice to name places after individuals).

Applicant's argument that purchasers would perceive HYDER as the phonetic equivalent of the English words "hide" or "hider" is also unpersuasive. As noted by the Examining Attorney, similar arguments have been rejected by the Court of Appeals for the Federal Circuit and the Board. See *Darty*, 759 F.2d, at 18, 225 USPQ at 654 (DARTY not understood by consumers to mean a play on the word "dart"); *In re Pickett Hotel Co.*, 229 USPQ 760, 761 (TTAB 1986)("Pickett" and "picket" not interchangeable); cf. *In re Monotype Corp. PLC*, 14 USPQ2d 1070, 1071 (TTAB 1989)(public

would not realize that CALISTO is not the "correct" spelling of the mythological name "Callisto").

In *Pickett Hotel*, *supra*, for example, the Board rejected applicant's argument that because the surname PICKETT is the phonetic equivalent of the word "picket," a word describing a type of fence or a labor demonstrator, a *prima facie* surname case had not been made out. The Board noted that acceptance of such arguments would automatically excuse from the proscription of Section 2(e)(4) "all surnames that sound like words having other ordinary meanings, a result which would emasculate the purpose of the statute to preclude registration of [words] which are primarily merely surnames." *Pickett Hotel*, 229 USPQ at 761. We believe that the same analysis applies to this case. There is simply no reason to believe that consumers encountering applicant's mark will understand it to mean the ordinary English words "hide" or "hider", rather than its primary surname significance.

With respect to applicant's listing of HYDER in a book of given names, such evidence has been given little weight. There is no evidence that consumers generally accept HYDER as a given name. See *Harris-Intertype*, 518 F.2d at 631, 186 USPQ at 240. In fact, the Examining Attorney's NEXIS evidence suggests that HYDER is rarely used as a given name.

Similarly, applicant's contention that HYDER is a Welsh term meaning "confidence" does not take the term out of the primarily merely a surname category. Applicant has not demonstrated that consumers in the United States are familiar with the Welsh language, or even that any Welsh speaking people in the United States would recognize that HYDER has a non-surname significance.

As to the remaining factors, we recognize that no one connected to applicant's organization has been shown to have the HYDER surname. However, the corporate name of applicant itself includes the HYDER surname, which we believe consumers would recognize as such. Also, it is the view of the Board that HYDER has the "structure and pronunciation" of a surname, rather than an arbitrary designation. See *Garan*, 3 USPQ2d at 1538; *Industrie Pirelli*, 9 USPQ2d at 1566.

Decision: The refusal to register the mark HYDER under Section 2(e)(4) is affirmed.

L. K. McLeod
Administrative Trademark
Judges, Trademark
Trial and Appeal Board

Simms, Administrative Trademark Judge, concurring:

I fully agree with the decision of Judge McLeod and her reasons for finding the mark HYDER to be primarily merely a surname. I would also point out that recent nationwide publicity given to Joerg Haider, a person with a phonetically equivalent surname to the one sought to be registered here, only reinforces my belief that one encountering the name HYDER in connection with applicant's services will perceive it as a surname. The name of Mr. Haider, the chairman of Austria's far-right Freedom Party, was widely reported by the national media when that party joined the Austrian government. Even more recently, when he resigned as the leader of this party, there appeared another round of publicity in national media about him. People who have heard the phonetically equivalent name Haider used as a surname may well be "conditioned" or "predisposed," when encountering the designation HYDER, to view it as a surname. Also, although "hider" is the phonetic equivalent of the designation HYDER, I do not believe that there is anything about applicant's services which would cause potential purchasers encountering these services to have any reason to believe applicant's mark were a play on this word. If applicant's services involved, say, private investigation services, or if applicant sought to register this

designation for a board game whose object was to "hide" from another player, then applicant might well have a reasonable argument for contending that the term may be perceived as other than a surname. Suffice it to say that I believe the Office has established a prima facie case of primary surname significance, and that applicant has not rebutted the showing of primary surname significance.

Finally, I believe the dissent is incorrect when it implies or suggests that a term may be held "primarily merely a surname" if it is "only a surname." That is clearly not the law, as the Court itself said in *Harris-Intertype*. If that were the law, the Court would have reversed the Board in that case because "HARRIS" was shown to have other meanings, including being the name of several towns and being used as a given name. The test, reiterated in a number of cases by our primary reviewing court and by this Board, as noted by Judge McLeod, is the primary significance of the term sought to be registered.

R. L. Simms
Administrative Trademark
Judge, Trademark Trial
and Appeal Board

Hanak, Administrative Trademark Judge, dissenting:

I respectfully dissent. In Benthin this Board set forth the "factors which are relevant to a determination of whether [the mark sought to be registered] would be perceived as primarily merely a surname." 37 USPQ2d at 1333. It was noted that while most of the factors were fairly objective, others were decidedly subjective.

In this case, there are four factors which are relevant in determining whether the service mark HYDER would be perceived as primarily merely a surname.

The first factor is the degree of rareness of this surname. In Benthin, it was noted that if the surname is indeed rare, then this first factor would "weigh in favor of a finding that [the mark sought to be registered] would not be perceived as primarily merely a surname." 37 USPQ2d at 1333. From a compilation of hundreds of telephone books containing over 90 million names, the examining attorney was able to retrieve only 1,840 Hyder surname listings. Thus, on average, for every 50,000 individuals listed in these hundreds of telephone books, there is but one individual with the surname Hyder. This demonstrates to my satisfaction that Hyder is indeed a rare surname, and hence

this first factor weighs in favor of finding that applicant's service mark HYDER will not be perceived as primarily merely a surname.⁸

The second Benthin factor which is pertinent to this case is whether there is "anyone connected with applicant" having the surname Hyder. 37 USPQ2d at 1333. As the majority acknowledges, no one connected with applicant has the surname Hyder, and thus this second Benthin factor likewise weighs in favor of finding that applicant's service mark HYDER would not be perceived as primarily merely a surname.

The third Benthin factor which is pertinent to this case is whether HYDER has any "meaning other than that of a surname." 37 USPQ2d at 1333. The examining attorney's own

⁸ The majority correctly notes that during the course of this proceeding, the examining attorney conducted two separate searches. The first telephone directory search revealed 1,514 individuals with the surname Hyder, and the second, more recent search revealed 1,840 individuals with the surname Hyder. However, it should be made clear that both searches were from the same source, namely the PHONEDISC which in 1995 was called the PHONEDISC U.S.A. and which in 1997 was renamed the PHONEDISC POWERFINDER USA ONE 1997. The 1997 PHONEDISC contained over 90 million names and it was the one which revealed that there were 1,840 individuals with the surname Hyder. The 1995 PHONEDISC contained over 83 million names of which 1,514 individuals had the surname Hyder. Thus, to be perfectly clear, the examining attorney's PHONEDISC search did not reveal that there were over 3,000 individuals with the surname Hyder (i.e. 1,840 + 1,514). Moreover, both editions note that they contain some duplicate listings. Thus, the number of Hyder listings may be less than 1,840.

evidence clearly establishes that HYDER has meanings other than that of a surname, and hence this third factor likewise weighs in favor of a finding that the service mark HYDER would not be perceived as primarily merely surname.

To elaborate, as the majority notes, the examining attorney submitted the first 50 stories he retrieved from the NEXIS database wherein the term HYDER appeared. Fifteen of these 50 stories were duplicates. An examination of the 35 stories revealed that in 24 of the stories, HYDER was used as a surname. However, in the other 11 stories, HYDER was used not as a surname, but rather as a first name, a middle name, a geographic term or in some other fashion. Thus, in nearly one third of the stories made of record by the examining attorney, HYDER was used in a manner other than that of a surname.⁹ Our primary reviewing Court has held that putting aside de minimis other meanings, a term can be held to be primarily merely a

⁹ In footnote 6, the majority appears to take a somewhat inconsistent view of the 35 articles made of record by the examining attorney. When 24 of the articles use HYDER as a surname, the majority believes that the public will recognize it as such. However, when the other 11 articles use HYDER as a first name, middle name or geographic term, the majority, without offering any explanation, apparently believes the public will not recognize it as such. Thus, the majority seems to feel that in article 1, consumers will not recognize HYDER as a first name when reference is made to "Hyder Zahed, manager of information services at Allergan Corp.," and yet in article 4, consumers will recognize HYDER as a surname when reference is made to "Jeremy Hyder."

surname if "it is only that [a surname]." In re Harris-Intertype Corporation, 518 F.2d 629, 186 USPQ 238, 239 (CCPA 1975) (original emphasis).¹⁰ When the examining attorney's own evidence reveals that nearly one third of the uses of HYDER are other than that of a surname, then it can hardly be said that HYDER is only (merely) a surname. Thus, as previously noted, this third factor likewise favors applicant's position that its service mark HYDER is not primarily merely a surname.

Finally, we turn to the fourth Bethin factor which is pertinent to this case, namely, whether HYDER "has the structure and pronunciation of a surname, or stated somewhat differently, the look and sound of a surname." 37 USPQ2d at 1333. As noted in Benthin, this fourth factor is

¹⁰ The concurring opinion is simply wrong in suggesting that the words "and it [the mark sought to be registered] is only that [a surname]," are those of the dissent. Those are words quoted by the Court in Harris with the original emphasis. 186 USPQ at 239. Moreover, in this case the examining attorney's own evidence (the 35 articles) show a two thirds/one third split between usage of HYDER as a surname and usage of HYDER as a first name, middle name, geographic term or otherwise. In Harris, there were of record over 1,900 listings of the surname Harris taken from the telephone directories of just two cities as compared to fewer than 20 uses of Harris other than as a surname. These fewer than 20 non-surname uses are truly de minimis when compared to the over 1,900 surname uses taken from the telephone directories of just two cities (as opposed to the entire United States, as is the case here). Finally, as for the concurring opinion's reference to Joerg Haider and how mention of Mr. Haider may "condition" or "predispose" the United States consuming public to view HYDER as a surname, suffice it to say that I believe the concurring opinion as far overstepped the limits of what this Board can properly take judicial notice.

very highly subjective. In my judgment, this fourth factor is neutral. As stated in Benthin, HYDER, like BENTHIN, "does not have the clear look and sound of a surname like Pirelli does, nor does it have the clear look and sound of an arbitrary term like Kodak does." 37 USPQ2d at 1333.

In sum, the first three fairly objective factors clearly favor applicant's position that HYDER will not be perceived as primarily merely a surname. The fourth highly subjective factor is neutral. Hence, in view of the foregoing, I would find that HYDER is not primarily merely a surname.

One final comment is in order. In Benthin this Board for the first time stated that on the issue of whether a term is primarily merely a surname, the Board was "inclined to resolve doubts in favor of the applicant and pass the mark to publication with the knowledge that others who have the same surname and use it or wish to use it for the same or similar goods or services can file a notice of opposition." 37 USPQ2d at 1334. At an absolute minimum, I believe that the examining attorney's own evidence establishes that there is a strong doubt as to whether HYDER would be perceived as primarily merely a surname. Accordingly, while I firmly believe that HYDER is not primarily merely a surname, I likewise feel that this Board

should adhere to the proposition set forth in Benthin of resolving doubts in applicant's favor on the question of whether applicant's mark is primarily merely a surname.

E. W. Hanak
Administrative Trademark
Judge, Trademark Trial
and Appeal Board